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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,436	09/29/2005	Jens Storkel	02894-0711US1/06651-PT22	6040
26161 7590 09/01/2010 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
GRANT, ALVIN J				
ART UNIT		PAPER NUMBER		
3723				
NOTIFICATION DATE		DELIVERY MODE		
09/01/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/535,436

Applicant(s)

STORKEL ET AL.

Examiner

ALVIN J. GRANT

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-9 and 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9 and 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date 5/24/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3, 5-9 and 11-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishihira et al. 4,330,578 in view of Morawski US 2001/0002605.

Regarding claims 1 and 3, Nishihira et al. discloses an injection molded part comprising: a body injection-molded from a first plastic (**1:54-56**), wherein the body comprises a transparent and/or opaque and/or translucent plastic; and an injection-molded encapsulation of a second plastic covering the decoration (**1:62-2:2**). Nishihira et al. does not specifically disclose a placing a decorative side of a decoration against the first injection-molded member. Morawski teaches that a decorative side of a decoration plastic may be bonded to a surface (**e.g., 0046**) so as to minimize wear on the surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made Nishihira et al.'s apparatus to have the decorative side of a decoration plastic may be bonded to a surface as taught by so as to minimize wear on the surface.

Referring to claims 5-9, 11-19 and 30, Nishihira et al. as modified discloses an injection molded toothbrush that comprises the claimed features that include, the first and second plastics have different degrees of hardness, decorations on both sides and

a second injection layer provided after the first layer and the application of decorations; and then encapsulate as appropriate. Nishihira et al., as modified, does not specifically disclose the specific locations of the decorations. The location of the decorated areas is a matter of design choice and these features are for decorative purposes and do not impact the structural integrity or the performance of the tooth brush. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made Nishihira et al.'s toothbrush to have the decorations at the locations as claimed as a matter of choice. **Referring to claims 20-29**, Nishihira et al., as modified, inherently discloses the claimed method steps while disclosing the apparatus. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. *In re King, 801 F.2d 1324,231 USPQ 136 (Fed. Cir. 1986)*. MPEP 2112.02. The claims are product by process claims and therefore the process has not been given patentable weight.

Response to Arguments

3. Applicant's arguments filed 5/24/10 have been fully considered but they are not persuasive.
4. It is noted that in a telephone conversation with Mr. Sean Dean on May 3, 2010, there was no agreement that Morawski disclosed a heat shrinkable film applied to a

toothbrush body rather than an injection-molded encapsulation covering a decoration applied to an injection molded body. The purpose of the call was to inform the examiner that in claim 20 the decorated surface of the film faced the molded surface on which it was bonded.

5. In response to Applicants argument that injection-molding process should be considered, Applicant must provide an affidavit disclosing the difference between the process used and that used in conventional methods, since the injection-molded process as disclosed in the prior art is substantially the same as that of Applicant's and the results are substantially equivalent.
6. Applicant's arguments with respect to claims 1, 3, 5-9 and 11-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN J. GRANT whose telephone number is (571)272-4484. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Grant/
Examiner, Art Unit 3723